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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/580,201	05/26/2000	J. Michael McIntosh	2314-187	8265

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ROTHWELL, FIGG, ERNST & MANBECK, P.C.
1425 K STREET, N.W.
SUITE 800
WASHINGTON, DC 20005

EXAMINER

BUGAISKY, GABRIELE E

ART UNIT PAPER NUMBER

1653

DATE MAILED: 03/26/2003

16

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/580,201

Applicant(s)

MCINTOSH ET AL.

Examiner

Gabriele E. BUGAISKY

Art Unit

1653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-10, 12-34 is/are pending in the application.
- 4a) Of the above claim(s) 15-18, 27, 28, 30 and 31 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 29 is/are allowed.
- 6) ☒ Claim(s) 1, 12, 19-26 and 32-34 is/are rejected.
- 7) ☒ Claim(s) 2-5, 7-10, 13-14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

The amendment of 11/26/2002 is acknowledged. Claims 6 and 11 have been cancelled and new claims 32-34 have been submitted. Claims 15-18, 27-28 and 30-31 remain withdrawn from consideration, and claims 1-5, 7-10, 12-14 19-26 and 32-34 are currently under consideration.

Specification

The disclosure remains objected to because it contains an embedded hyperlink and/or other form of browser-executable code (e.g., page 1, lines 26-27, page 2, line 5, page 6, line 11, etc.). Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

It is noted that Applicants have amended the specification in an attempt to comply with this requirement; however, the websites may still be identified as embedded hyperlinks.

Claim Objections

The objection to Claim 12 under 37 CFR 1.75(c), as being of improper dependent form is withdrawn, based upon the amendment.

The objection to claims 2-12 and 29 because of non-elected subject matter is withdrawn, based upon the amendment.

Correction to the spelling errors of claims 2, 12 and d24 is noted; the objection to these claims is withdrawn.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 12 and 19-26 remain and claims 32-34 are newly rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is still not clear what distinction is to be made in claims 1 and 12 between a “synthetic” amino acid and a “non-natural derivative” of an amino acid. Furthermore, how is, e.g., a synthetic phenylalanine distinguishable from a naturally occurring phenylalanine?

Applicants arguments are noted but are not persuasive. It is stated that the claims are clear as written. It is stated that the intent of the term “synthetic amino acid” was to include synthetic basic amino acids, which would not include naturally occurring basic amino acids, whether natural or synthetic. It was stated that these distinctions are likewise applicable to the other terms about which the Examiner raised concern. There is nothing in the specification, as far as can be determined, which defines the term “synthetic amino acid” as Applicants state was intended. All examples in the specification are non-limiting. Even assuming *arguendo*, that “synthetic amino acid” is to be interpreted as intended, then how does a non-natural derivative of an amino acid differ from the “synthetic amino acid”. The Examiner remains baffled by what is intended by these terms.

Claims 19-26 and 32-34 are included in this rejection as they ultimately depend from claim 1 and do not clarify the ambiguity.

Claim Rejections - 35 USC § 102

The rejection of claim 12 under 35 U.S.C. 102(e) as being anticipated by US 5885797 (Chen *et al.*) is withdrawn, based upon the amendment.

Conclusion

Claim 29 is allowed.

Claims 2-5, 7-10, and 13-14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

Art Unit: 1653

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

This application contains claims 15,-18, 27-28, and 30-31 drawn to an invention nonelected with traverse in Paper No. 9. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gabriele E. BUGAISKY whose telephone number is (703)308-4201. The examiner can normally be reached on 8:15 AM- 2 PM, Tu & Th, 8:15 AM-1:30 PM, We & Fr.

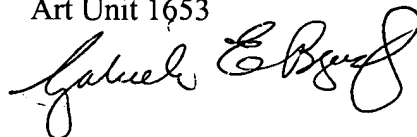
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher SF Low can be reached on (703) 308-2923. The fax phone numbers for the organization where this application or proceeding is assigned are 703 308-4242 for regular communications and 703 308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 708 308-0196.

Gabriele E. BUGAISKY

Primary Examiner

Art Unit 1653



March 23, 2003

**GABRIELLE BUGAISKY
PRIMARY EXAMINER**